

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Georg PODHAJSKY et al.)	
)	Group Art Unit: 3684
Application No.: 10/525,732)	
)	Examiner: Nancy T. MEHTA
Filed: February 3, 2006)	
)	Confirmation No.: 8294
For: BUSINESS APPLICATION)	
GENERATION SYSTEM)	

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

Via EFS-Web

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply to Examiner's
Answer dated March 29, 2010.

I. ARGUMENT

In addition to the arguments for reversal of the outstanding final rejection
provided in Appellants' Appeal Brief filed on December 30, 2009, Appellants provide the
following remarks regarding the Examiner's Answer ("Answer") mailed March 29, 2010.

In the Answer, the Examiner withdrew the rejections of claims 1, 18, and 20
under 35 U.S.C. § 112, second paragraph. Answer, page 19. However, the Examiner
has maintained that claims 14, 33, and 37 remain rejected under 35 U.S.C. § 112,
second paragraph. Specifically, the Examiner alleges that "[i]n claims 14, 33, and 37,
... there is still room for interpretation that at least some of the steps or processes in the

above claims can be performed manually." Answer, page 20. The Examiner's allegations are incorrect.

Paragraph [013] of Appellants' specification states that "[s]till further, the invention provides for computer program products for generating business software applications and adapted business software applications, respectively, the computer program products comprising instructions to cause a processor of a computer to execute the steps according to the invention as described in more detail below." Further, paragraph [012] of Appellants' specification states that "[t]hus, the invention makes it possible that a customized business software application is not only generated automatically but also adapted, amended or altered according to changing requirements after a certain time. This is achieved by providing a set of meta data which can be customized by a user via input/output means such as a workbench and by processing said set of meta data through a generation tool according to the invention." Appellants submit that "[i]f the claims when read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more." *S3, Inc. v. Nvidia Corp.*, 259 F.3d 1364, 1367, 59 USPQ2d 1745, 1747 (Fed. Cir. 2001), quoting *Miles Laboratories, Inc. v. Shandon*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993). Accordingly, in view of the foregoing, Appellants submit that claims 14, 33, and 37 meet the requirements of 35 U.S.C. § 112, second paragraph. Therefore, Appellants respectfully request that the Board to reverse the rejection of the above claims under 35 U.S.C. § 112, second paragraph.

Regarding the rejection of 35 U.S.C. § 101, the Examiner withdrew claims 1 and 20. Answer, page 20. However, the Examiner maintained that claims 14, 33, and 37

remain rejected under 35 U.S.C. § 101. Answer, page 22. Specifically, the Examiner alleges that there is question as to whether "a human [is] provided a set of meta data ... [o]r is this process being performed by a computer platform ...?" *Id.* These allegations are incorrect. Appellants note that "each step" in a statutory method claim need not be carried out by a computer. According to In re Bilski, "a claimed process is purely patent-eligible under §101 if (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." In re Bilski, 545 F.3d 943, at 954. Independent claim 14 recites "importing into a generation tool," which includes statutory subject matter under In re Bilski. Accordingly, claim 14 recites statutory subject matter. Independent claims 33 and 37 recite elements similar to those recited above of claim 14, and therefore also recite statutory subject matter. Therefore, these independent claims, as well as claims 17 and 36 that depend from the independent claims, are statutory, and the rejection of these claims should be reversed for at least the above reasons.

Regarding the rejection under 35 U.S.C. § 103, the Examiner contends that the generator program (28) teaches the claimed "first tool" and the design program (2[6]) teaches the claimed "second tool," as recited in claim 1, citing paragraphs [0037] and [0038] of *Lee*. Answer, page 28. This is incorrect.

In *Lee*, "the generator program 28 may accept as input an XML meta document that contains system design information generated by the design program 26." Paragraph [0037]. That is, design program 26 generates input data to generator program 28. Thus, in *Lee*, rather than processing data as input to design program 26, generator program 28 receives processed data from design program 26. Accordingly,

contrary to the Examiner's allegations, generator program 28 does not constitute as the claimed "first tool," which "processes ... data for **input to said generating element**," as recited in claim 1 (emphasis added).

The Examiner then contends that "interpretation of computer programs" recited in paragraph [0100] of *Lee* teaches "interpreting ... said set of customized meta data" and "translating said ... data into customized business process data **for input into said generating element**," as recited in claim 1 (emphasis added). Answer, page 34. This is incorrect.

Paragraph [0100] of *Lee* discloses that "the computer-readable medium could even be paper or another suitable medium upon which the program is printed, as the program can be electronically captured, via for instance optical scanning of the paper or other medium, then compiled, **interpreted** or otherwise processed in a suitable manner if necessary, and then stored in a computer memory" (emphasis added). That is, Paragraph [0100] of *Lee* merely discloses that the program in *Lee* may generally be compiled or interpreted in a format that can be stored in a computer memory. Paragraph [0100] of *Lee*, however, fails to disclose or suggest "**interpreting ... said set of customized meta data**" and "**translating said ... data into customized business process data for input into said generating element**," as recited in claim 1 (emphasis added). Therefore, in view of the foregoing, *Lee* does not teach or even suggest all of the elements of claim 1 for at least the above reasons.

For at least the above reasons, the Examiner has not demonstrated that *Lee* teaches or suggests all of the elements of claim 1. Therefore, the Board should reverse the rejection of claim 1, and of independent claims 14, 18, 20, 33, and 37, which are

rejected for similar reasons as independent claim 1. Claims 3-9, 12, 13, 17, 22-28, 30-32, and 36 depend from the independent claims and are allowable at least due to their dependence.

II. CONCLUSION

For at least these reasons and the reasons given in Appellants' Appeal Brief filed on December 30, 2009, Appellants respectfully request the Board to reverse the final rejection of claims 1, 3-9, 12-14, 17, 18, 20, 22-28, 30-33, 36, and 37.

Respectfully submitted,

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Dated: May 13, 2010

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